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| 09/915,685 | 07/26/2001 | William T. Wilkinson | WIL-106US | 7603 |
| 31344 | 7590 | 03/02/2006 | EXAMINER | |
| RATNERPRESTIA | | | DASS, HARISH T | |
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| WILMINGTON, DE 19899 | | | PAPER NUMBER | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/915,685 | Applicant(s) WILKINSON ET AL. | |
| | Examiner Harish T. Dass | Art Unit 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/31/03, 1/29/03</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS 4/24/02, 1/08/02, 12/7/01</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6, 13, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 - Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "non-IP-based" in claim 5 is used by the claim to mean "non intellectual property based", while there is not such an accepted (known) term that Examiner knows of it. The term is indefinite because the specification does not clearly redefine the term.

Claims 6, 13 and 36 the phrase "and/or" renders the claims indefinite because, it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For purpose of examination only, Examiner assumes that the claim limitation is "or". For example, see claim 6 the third line the phrase "and/or" renders the claims indefinite. Similarly, claims 13 and 36.

Double Patenting

2. Claim 24 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 23. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott (PGPUB US 2001/0042034).

Re. Claim 34 Elliott discloses identifying one or more intellectual property investments [para. 0020; page 12 claim 1], identifying relevant valuation and risk factors for each intellectual property investment [para. 0205; 0069; 0114],

(d) managing, selecting or recommending one or more intellectual property investments based upon the total net intellectual property asset value and the risk factors [para. 0046; para. 0205; 0069; 0114; 0111; page 12 claim 1 – net asset is part of balance sheet]. Elliott does not explicitly disclose calculating a total net intellectual property

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asset value for each intellectual property investment. However these are well known steps in financial statement analysis to provide financial information about an entity, which directly influences the decision making of investors whether to invest, or not. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Elliott and include calculating a total net intellectual property asset value for each intellectual property investment to represent the monetary value of the intellectual property and enable investors to make decision based on the monetary value of intellectual property to invest.

Re. Claim 35, Elliott discloses comparing a plurality of intellectual property investments to one another based upon the corresponding total net intellectual property asset value (or asset) and the risk factors for each [para. 0112-0114].

Re. Claim 36, Elliott discloses wherein the intellectual property investment comprises an intellectual property asset; an intellectual property asset and one or more related assets; or one or more controlling, owning, or creative entities of one or more intellectual property assets [para. 0066-0068; 0078 and page 12 claim 1].

Claims 1-33 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott (PGPUB US 2001/0042034) in view of Gatto (US 6,510,419).

Re. Claims 1-2, and 33 Elliott discloses providing an accounting for an intellectual property investment [Abstract; paragraph or para. 0002; 0016; and 0006-0007], providing a valuation with respect to the intellectual property investment [para. 0012], performing financial analysis related to the intellectual property investment [para. 0027; 0033-0034] and managing the investment based upon the accounting, valuation, and analysis for the investment [para. 0046]. Elliott does not explicitly disclose making a recommendation based upon the financial analysis, and wherein the recommendation is a financial transaction recommendation selected from the group consisting of: buy, hold, and sell. However, Gatto discloses these steps [abstract; C1 L19-L35; C2 L42-L47; C23 L12-L45] to provide a tool for analysis of past performance to predict future performance and recommendation. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Elliott and include making a recommendation based upon the financial analysis, as disclosed by Gatto, to provide future recommendation based on the financial analysis of past estimates.

Re. Claim 3, Elliott discloses comparing financial information relating to the intellectual property investments to one or more other intellectual property investments [para. 0112-0114]. Gatto further discloses comprises computing one or more financial ratios or indices [C25 L10-L19] to allow the user to manage the financial information. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Elliott and Gatto and provide a tool for financial analysis for intellectual properties and comparing the financial performance of the

intellectual properties.

Re. Claim 4, Elliott discloses applying the process to one or more stages of a life cycle of the intellectual property investment [para. 0035].

Re. Claim 5, Elliott discloses incorporating the process into a non-IP-based financial analysis, earnings-per-share estimation, and recommendation process [para. 0068; 0070-0071; 0082; 0169-0204].

Re. Claim 6, Elliott discloses wherein the intellectual property investment comprises an intellectual property asset; and one or more related assets; or one or more controlling, owning, or creative entities of one or more intellectual property assets [para. 0066-0068; 0078 and page 12 claim 1].

Re. Claim 7, Elliott discloses wherein the accounting step comprises identifying one or more intellectual property assets and verifying ownership of each asset [para. 0020; page 12 claim 1].

Re. Claim 8, Elliott discloses wherein the accounting step further comprises classifying the one or more intellectual property assets and recording a cost or book value for each asset [para. 0033-0034].

Re. Claim 9, Elliott discloses wherein the accounting step further comprises compiling and recording an inventory of a plurality of intellectual property assets [para. 0114; 0027].

Re. Claim 10, Elliott discloses wherein the valuation step comprises determining whether one or more intellectual property assets are valid [para. 0020; 0023].

Re. Claim 11, Elliott discloses wherein the valuation step further comprises one or more of the following steps: (c1) computing a basic liquidation or collateral value of the intellectual property asset, (c2) computing an estimated intellectual property asset fair market value, (c3) computing an intellectual property asset fair market value by transactions in a financial market, and (c4) computing an intellectual property distressed asset valuation [para. 0145-0152; 0157; 0205].

Re. Claim 12, Elliott discloses wherein computing the estimated intellectual property asset fair market value comprises identifying and taking into account a plurality of valuation and risk factors [para. 0205; 0069; 0114].

Re. Claims 13-14, Elliott wherein the investment comprises a controlling, owning, or creative entity of one or more intellectual property assets and the method further comprises developing a total asset value for each intellectual property asset relating to the entity [para. 0192; para. 0066-0068; 0078 and page 12 claim 1].

Elliott or Gatto does not explicitly disclose summing the total asset values for each asset relating to the entity to determine a total net intellectual property asset value for the entity and wherein the analysis step comprises computing impact of the total net intellectual property asset value on earnings per share/unit and share/unit price of a security related to the entity. However these are well known steps in financial statement analysis to provide financial information about an entity which directly influences the decision making of investors whether to invest or not, similarly it provides information to the management how to plan for future of the entity. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Elliott and Gatto include summing the total asset values for each asset relating to the entity to determine a total net intellectual property asset value for the entity and wherein the analysis step comprises computing impact of the total net intellectual property asset value on earnings per share/unit and share/unit price of a security related to the entity and provide financial analysis with know ratios to help investor and management to understand the health of the company.

Re. Claim 15, Elliott discloses comparing or ranking the intellectual property investment to one or more other investments, and analyzing risk factors relating to the investment [para. 0112-0114]. Gatto further discloses computing one or more intellectual property financial ratios or indices for the investment [C25 L10-L19] to allow the user to manage the financial information. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Elliott and Gatto

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and provide a tool for financial analysis for intellectual properties and comparing the financial performance of the intellectual properties.

Re. Claims 16-19, Elliott discloses total intellectual property value divided by net worth or book value [para. 0033-0034]. Gatto discloses ratios [C25 L10-L19]. Elliott or Gatto does not explicitly disclose total assets, total revenues, total net income, or number of shares or units; total intellectual property value per share or unit as a percentage of earnings per share or unit, total market capitalization, or share or unit book value or fair market value, wherein the financial index comprises a representative sample designed to track general market price performance of assets, or designed to track performances of a particular segment, and generating one or more periodic investment performance reports reporting a rate of return and risk related to one or more of the intellectual property investments, and confirming accuracy of the investment performance reports through independent, third party validation. However, these are well known steps in financial analysis and corporation performance auditing. to provide financial information about an entity which directly influences the decision making of investors whether to invest or not, similarly it provides information to the management how to plan for future of the entity. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Elliott and Gatto include the above limitations and provide financial analysis reports with know ratios to help investor and management to understand the health of the company and provide auditing by third party to conform to government regulation or company policy.

Re. Claims 20-21, Elliott discloses comprising a first entity using the method to manage intellectual property investments controlled, owned, created or a combination thereof by the first entity and comprising a first entity using the method to invest in intellectual property investments not controlled, owned, or created by the first entity [para. 0031; 0066-0068; 0078; and page 12 claim 1].

Re. Claims 22-24, Elliott discloses wherein the process comprises changing an intangible value for intellectual property to a tangible value and wherein the process comprises changing a first tangible value for intellectual property to a second tangible value [para. 0006; 0026; 0044].

Re. Claims 25-27, Elliott discloses comprising conducting one or more financial transactions based upon the valuation, analysis, and recommendation steps [para. 0013; 0139], and wherein the creative entity is an individual and comprising tracking performance of one or more creative individuals [para. 0018; 0047].

Re. Claim 28, Elliott discloses comprising ranking (comparing) one or more entities by type of intellectual property controlled, owned, or created; number of intellectual property assets controlled, owned, or created; or value of intellectual property assets controlled, owned, or created [para. 0066-0068; 0078 and page 12 claim 1].

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Re. Claim 29, Elliott discloses determining for an entity or a security related to the entity, one or more of: estimated security price, estimated change in security price, projected earnings, or projected change in earnings [para. 0027]. Elliott does not explicitly disclose recommending buying, holding, or selling the security based upon the estimate or projection. However, Gatto discloses these steps [abstract; C1 L19-L35; C2 L42-L47; C23 L12-L45] to provide a tool for analysis of past performance to predict future performance and recommendation. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Elliott and include making a recommendation based upon the financial analysis, as disclosed by Gatto, to provide future recommendation based on the financial analysis of past estimates.

Re. Claims 30-32, Elliott discloses creating an accounting report for an entity showing a balance sheet and income statement reflecting the valuation and earnings of the intellectual property assets corresponding to the entity [para. 0115-0116 – see balance sheet]. Gatto further discloses interfacing with one or more accounting entities for performing the accounting and valuation steps and determining one or more investment objectives/strategies, conducting one or more financial transactions concerning the investment, and monitoring/tracking performance of the investment [Abstract; C5 L43-L56] to facilitate analysis one or more securities using data visualizing technique. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Elliott and include graphic user

interface to allow the user to enter the data for analysis and visually display the recommendation on screen.

Re. Claims 37-40, Elliott discloses financial analysis related to an intellectual property investment [para. 0027; 0033-0034; 0012]. Elliott does not explicitly disclose making a recommendation and prior to making the recommendation, performing the financial analysis, prior to performing the financial analysis, performing a valuation for the investment based upon the accounting for the investment, and making an investment decision based upon the distressed asset valuation. However, Gatto discloses making a recommendation [abstract; C1 L19-L35; C2 L42-L47; C23 L12-L45] to provide a tool for analysis of past performance to predict future performance and recommendation.

Performing the financial analysis, prior to performing the financial analysis, performing a valuation for the investment based upon the accounting for the investment, and making an investment decision based upon the distressed asset valuation is business decisions whether an investor (entity) invests (purchase intellectual property or license one) before analysis or after it is up to the priorities of the management, similarly the how does the business value its purchase. For example, FCC auctions a radio spectrum, one investor may purchase it without any consideration of money or market while other investor may evaluate it if it is worthy for him/her to invest without a sense of making/losing money. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Elliott and include making a recommendation based upon the financial analysis, as disclosed by Gatto, or

by business consideration, to provide future recommendation based on the financial analysis of past estimates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

A handwritten signature in black ink that reads "Harish T. Dass". The signature is written in a cursive style with a horizontal line underneath the name.

HTD